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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,831	10/11/2001	Kamal Acharya	NETS0085	3000

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EXAMINER

GART, MATTHEW S

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/975,831

Applicant(s)

ACHARYA ET AL.

Examiner

Matthew s Gart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 5-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3 and 5-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claims 2 and 4 were canceled and claims 1, 3, 5, 22 and 23 were amended via Paper No. 13. Claims 1, 3 and 5-25 are pending in the instant application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3 and 5-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pricescan.com (PTO-892, Ref U) in view of Giovannoli U.S. Patent No. 5,758,328.

Referring to claim 1. Pricescan.com discloses a method for providing an integrated electronic list of providers (page 3), comprising the steps of:

- Determining at least one online provider for an item (page 4, "Does a vendor need to have a web site to be included in the shopping guide");
- Determining at least one offline provider for the item (page 4, "Does a vendor need to have a web site to be included in the shopping guide");
- Wherein the determining step follows a request for a product (page 10);
- Wherein when the request is for a desired geographical area, a user may choose one of several target locations, which have been previously created and stored; and

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- Integrating the at least one online provider with the at least one offline provider to provide an integrated list of providers for the item (page 4, "Does a vendor need to have a web site to be included in the shopping guide").

Pricescan.com does not expressly disclose a method for providing an integrated electronic list of providers wherein the request is for a desired geographical area, a user may choose one of several target locations, which have been previously created and stored. Giovannoli discloses a method for providing an integrated electronic list of providers wherein the request is for a desired geographical area (Giovannoli: abstract), a user may choose one of several target locations, which have been previously created and stored (Fig. 6). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the method of Pricescan.com to include the limitations Giovannoli as discussed above in order to allow the consumer to save money and help take the hassle out of shopping (Pricescan.com: Page 3).

Referring to claim 3. Pricescan.com further discloses a method wherein the request is for a product category (page 3).

Referring to claim 5. Pricescan.com in view of Giovannoli discloses a method according to claim 1 as indicated supra. Pricescan.com does not expressly disclose a method wherein the request is for a desired geographical area or for a predetermined proximity to a target location. Giovannoli discloses a method wherein the request is for a desired geographical area or for a predetermined proximity to a target location (abstract). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the apparatus, system, and method of

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Pricescan.com to include the limitations Giovannoli as discussed above in order to allow the consumer to save money and help take the hassle out of shopping (Pricescan.com: Page 3).

Referring to claim 6. Pricescan.com further discloses a method including providing comparison information for the at least one online provider and the at least one offline provider (page 3 – page 5).

Referring to claims 7-13. Pricescan.com further discloses a method wherein the comparison information includes price, rating, review, availability, promotion, electronic wallet, and return-policy comparison (full text).

Referring to claim 14. Pricescan.com further discloses a method providing comparison information about at least two offline providers (page 4).

Referring to claims 15-16. Pricescan.com further discloses a method wherein the comparison information includes in-store return policy and in-store pickup policy of online purchases (page 4).

Referring to claims 17-18. Pricescan.com further discloses a method wherein the comparison information includes special promotions and coupon-availability information (page 4).

Referring to claims 19-20. Pricescan.com in view of Giovannoli discloses a method according to claim 14 as indicated supra. Pricescan.com does not expressly disclose a method wherein the comparison information includes proximity and direction to the at least two offline providers. Giovannoli discloses a method wherein the comparison information includes proximity and direction to the at least two offline

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providers (abstract). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the apparatus, system, and method of Pricescan.com to include the limitations Giovannoli as discussed above in order to allow the consumer to save money and help take the hassle out of shopping (Pricescan.com: Page 3).

Referring to claim 21. Pricescan.com further discloses a method wherein the comparison information includes user review (page 12).

Referring to claim 22. Claim 22 is rejected under the same rationale as set forth in claim 1.

Referring to claim 23. Claim 23 is rejected under the same rationale as set forth in claim 1.

Referring to claim 24. Pricescan.com further discloses a computer system implement on a network environment (full text).

Referring to claim 25. Pricescan.com further discloses a computer system wherein the network environment further comprising a global communications network (full text).

Response to Arguments

Applicant's arguments with respect to claims 1, 3 and 5-25 have been considered but they are not persuasive.

The Attorney reiterates arguments that have been previously presented and addressed.

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The Attorney argues that Giovannoli U.S. Patent No. 5,758,328 does not disclose a computerized system for forming a computer based communications network of network members inclusive of network buyers and or network vendors for processing requests for quotations for goods and services through at least one central processing unit including operating system software for controlling the central price.

The Examiner notes, In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that there is not a sufficient suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the method of Pricescan.com to include the limitations Giovannoli as discussed above in order to allow the consumer to save money and help take the hassle out of shopping (Pricescan.com: Page 3).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Matthew Gart whose telephone number is 703-305-5355. This examiner can normally be reached Monday-Friday, 8:30AM-5:30PM EST.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MSG

June 14, 2004



Jeffrey A. Smith
Primary Examiner